

REMARKS

Please note that it appears there may be some confusion over the ownership and prosecution of the present application. Mr. Kenneth J. Cool, Reg. No. 40,570, called and discussed the ownership issue with the Examiner's Supervisor, Mr. David Ometz on May 18, 2006. As discussed with Mr. Ometz, our client, Transpacific Optics LLC, acquired this patent application from Mustek Systems, Inc. The assignment of ownership from Mustek Systems, Inc. to Transpacific Optics LLC was executed on December 02, 2005 and was recorded in the Patent Office at least as early as January 17, 2006 according to the Patent Assignment Abstract of Title database. This assignment was recorded at Reel/Frame number 017480 / 0325. A statement under 37 CFR 3.73(b) was submitted to the USPTO on May 16, 2006 along with a grant of Power of Attorney to practitioners associated with Customer No. 00043831 and a revocation of all previous powers of attorney. Furthermore, a subsequent 3.73(b) statement and a copy of the Assignment from the inventors to Mustek Systems, Inc. dated April of 2001 was submitted to the USPTO on March 18, 2006. It is hereby respectfully request that the Amendment filed on April 28, 2006 officially be stricken from the record.

Turning now to prosecution matters, the present patent application has been reviewed in light of the office action mentioned above, in which claims 15, 20, 28, and 34 are objected to because of various informalities listed in the office action. Claim 34 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 15-17, 28, and 29 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hashimoto et al., U.S. Patent No. 6,111,604 (hereinafter "Hashimoto"). Claim 18 is rejected under 35 U.S.C. § 103(a) as being

unpatentable over Hashimoto in view of Maxium Technologies (Internet Publication, 2000). Claims 19, 30, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Ochi et al., U.S. Patent No. 6,233,014 (hereinafter "Ochi"). Claims 20, 21, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Haranishi, U.S. Patent No. 5,764,779 (hereinafter "Haranishi"). Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Ochi and in further view of Maxium Technologies. Reconsideration of the above-referenced patent application in view of the foregoing amendment and following remarks is respectfully requested.

Claims 15-21 and 28-41 are pending. Claims 15-21 and 28-34 have been amended. Claims 35-41 have been added.

Objections Based on Informalities

Claims 15, 20, 28, and 34 are objected to because of various informalities listed in the office action. Claims 15, 20, 28, and 34 have been amended to correct the informalities.

Rejections under 35 U.S.C. § 112

Claim 34 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 34 has been amended in order to overcome the rejection.

Rejections under 35 U.S.C. § 102(e)

Claims 15-17, 28, and 29 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hashimoto. However, Hashimoto does not disclose "producing a

multimedia data file if the second digital signal matches predetermined data, wherein the multimedia data file comprises digital image and sound information derived from the first and second digital signals” as claimed in amended claim 15. Similarly, Hashimoto does not disclose “producing a multimedia data file comprising digital image and sound information if said sound digital signal matches predetermined data” as claimed in amended claim 28. Therefore, independent claims 15 and 28 and the claims that depend from them are believed to patentably distinguish from the cited patent. It is, therefore, respectfully requested that the Examiner withdraw the rejection as to these claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patent for additional reasons; however, the foregoing is believed to be sufficient.

Rejections under 35 U.S.C. § 103(a)

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Maxium Technologies. Claims 19, 30, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Ochi. Claims 20, 21, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Haranishi. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Ochi and in further view of Maxium Technologies. However, because neither Hashimoto nor Maxium Technologies nor Ochi nor Haranishi disclose the claim elements discussed above, even if there was a suggestion or teaching to combine the cited patents and/or Internet publication, and Assignee respectfully submits that there is no such teaching or suggestion, the resulting combination would still lack at least one element of the rejected claims. Therefore, claims 18-21 and 30-33 are believed to patentably distinguish from the cited

patents and Internet publication. It is, therefore, respectfully requested that the Examiner withdraw the rejection as to these claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patents and/or Internet publication for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500.

Reconsideration of the present patent application and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

Dated: 5/19/06

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Subject: RESPONSE TO OFFICE ACTION FOR APP. SER. NO. 09/884,925; Our File - 112.P55008
Attachments: Fax.tif

Attached for filing for App. Ser. No. 09/884,925 for a MULTIMEDIA DATA FILE PRODUCER COMBINING IMAGE AND SOUND INFORMATION TOGETHER IN A DATA FILE are the following documents:

1. Fee Transmittal (1 page); and
2. Amendment (12 pages).

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